



ATTORNEY DOCKET No. 114596-03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/385,394 Confirmation No.: unassigned
Applicant: John S. Yates, Jr., et al.
Title: COMPUTER WITH TWO EXECUTION MODES
Filed: August 30, 1999
Art Unit: 2183
Examiner: Richard Ellis

Atty. Docket: 114596-03-4000
Customer No. 38492

FOURTH RESPONSE TO OFFICE ACTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant responds to the Office Action of October 25, 2004 as follows.

REMARKS

I. Paragraphs 5-8: Incorporation by Reference

Paragraphs 5-8 of the Office Action question incorporation by reference of material.

The material incorporated by reference into this application fully complies with all rules, including MPEP § 608.01(p)(A).

First, MPEP § 608.01(p)(B) states that there is no limit on material that may be incorporated from priority applications. As noted in the first sentence of this application, the applications incorporated by reference are priority applications, and thus under MPEP § 608.01(p)(B), any limitations on incorporation by reference “do not apply.” Paragraph 7 of the Office Action has no legal basis.

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on November 28, 2005 as First Class Mail in an envelope with sufficient postage addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Tim E. Boyd

Second, the Office Action reflects an incomplete reading of MPEP § 608.01(p)(A). § 608.01(p)(A) only limits incorporation of “essential material,” and identifies “essential material” as “that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) provide the best mode (35 U.S.C. 112).” § 608.01(p)(A) clarifies that the following are necessary elements of any objection:

- identify particular claims to which the material is “essential”
- identify the legal basis under which the material is essential – enablement, written description, best mode, or other
- identify the material that is “essential” to the identified claims

The Office Action never makes any averment that the material is “essential material” – if the material is not “essential,” § 608.01(p)(A) states that such “nonessential subject matter may be incorporated by reference...” Further, without the three required showings, it is not at all clear that any requirement has any valid legal basis, and no applicant can make an informed decision on how to respond to a requirement. Until a requirement is stated with sufficient specificity to determine whether the requirement is properly grounded, or what type of response is appropriate, no further action is possible.

Third, as the Office Action itself acknowledges, the material submitted on microfiche is not a “computer program listing.” Therefore, new 37 C.F.R. § 1.96 does not constrain the form in which the material may be submitted. Further, the material submitted on microfiche exceeds the size of an appendix that may be submitted for printing under either old or new Rule 96, and it is not the type of information that may allowably be submitted on CD-ROM. In absence of any other appropriate medium, microfiche is an entirely proper way to place this material in the file for incorporation by reference.

No incorporation by reference breaches any rule, past or present. Any objections may be withdrawn.

Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any further extension of time is required, Applicant petitions

for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

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Dated: November 28, 2005

By: 

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